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10/771,994	02/04/2004	Nicholas J. Caunter	600.1302	3574
23280	7590	05/04/2006	EXAMINER	
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NEW YORK, NY 10018			ART UNIT	PAPER NUMBER
			3651	

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/771,994  
Filing Date: February 04, 2004  
Appellant(s): CAUNTER, NICHOLAS J.

**MAILED**

MAY 04 2006

**GROUP 3600**

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For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 02/13/2006 appealing from the Office action mailed 08/01/2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,954,323	EMIGH et al.	09-1999
4,852,722	HOUSEMAN	08-1989
EP0771675	MULLER	07-1997

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4, 7-9, 11-13, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Emigh et al. USP 5,954,323.

Emigh et al. '323 disclose a similar device comprising a(n):

Moving arm (17)

First gripper (24)

Electromechanical actuator (cylinder 28 is air & electrically operated)

Controller (Figure 5B)

Second gripper (23)

Solenoid valve (33)

2. Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Houseman USP 4,852,722.

Houseman '722 discloses a similar device comprising a(n):

Reciprocating or rotating an arm (Figure 6b; C12/L27-35, C2/L23-30)

Electronically controlling the gripper (C12/L27-35, C2/L23-30)

Adjusting a closing the distance or the first gripper as a function of the signature thickness or material (the gripper is appropriately set so as to function in accordance with the signature).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over as being unpatentable over Muller EP 0771675A1 in view of Emigh et al.

5,954,323. Muller '675 discloses a similar device comprising a(n):

Moving arm (Figure 2) that is a rotating arm

First gripper (19)

Second gripper (Figure 2)

Muller '675 does not disclose an electromechanical actuator connected to the first gripper for opening and closing the first gripper with the electromechanical actuator being mounted on the moving arm.

Emigh et al. '323 teach the use of an electromechanical actuator (28, 33) connected to a first gripper for opening and closing the first gripper with the electromechanical actuator being mounted on a moving arm (17) for the purpose of providing for a means of operating the gripper.

It would have been obvious to one having ordinary skill in the art at the time of the invention to have employed the use of an electromechanical actuator connected to a first gripper with the electromechanical actuator being mounted on a moving arm, as taught by Emigh et al. '323, in the device of Muller '675 for the purpose of providing for a means of operating the gripper.

Re claim 2, Emigh et al. '323 teach a controller for the purpose of controlling the actuator.

#### ***Allowable Subject Matter***

Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### (10) Response to Argument

#### Rejection under Emigh et al. 5,954,323

##### A. Claims 1-3, 7-9, and 16:

Appellant argued that Emigh et al. '323 is not "a device for removing folded signatures from a saddleback conveyor". Hence, Emigh et al. '323 does not anticipate the claimed invention. This argument is not persuasive. Appellant has failed to positively identify the saddleback conveyor as part of the claimed combination. Emigh et al. '323 device anticipates all structural limitations per claimed invention. Therefore, Emigh et al. '323 is a proper 102 rejection.

Appellant argued that Emigh is not a "rotating arm rotating a full rotation". Appellant insisted that the phrase "full rotation" should be interpreted as 360-degree rotation. Nevertheless, Appellant's original specification is silent as to the specific of the "full rotation" being a 360-degree rotation. Appellant's drawings also failed to provide a 360-degree rotation. The movement/arc arrows in the drawings do not necessarily indicate 360-degree rotation. Appellant's argument concerning the interpretation of "full rotation" is not persuasive. It is the Office's position that Emigh et al. '323 arm does in fact rotate fully within the predetermined rotational arc of the arm. In other words, "full rotation" does not necessarily mean 360 degrees.

Emigh et al. '323 comprise an electromechanical actuator being mounted on the moving arm. The actuator is electrically and automatically controlled. Hence, it is an electrical mechanical element. There is no specific language in the claim to support

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Appellant's notion that "solenoid 52 is mounted to the rotating arm permitting purely electronic controls..."

B. Claims 11, 12, and 13:

As discussed above, Emigh et al. '323 anticipate the claimed "device". Emigh et al. '323 comprise electromechanical actuator being mounted on the moving arm.

**Rejection under Houseman 4,852,722**

Appellant argued that Houseman '722 does not provide "a method for removing printed products from a saddleback conveyor". Hence, Houseman '722 does not anticipate the claimed invention. This argument is not persuasive. Appellant has failed to positively identify the saddleback conveyor as part of the claimed combination. Houseman '722 device anticipates all limitations per claimed invention. Therefore, Houseman '722 is a proper 102 rejection.

**Rejection under Muller EP 0771675 in view of Emigh et al. 5,954,323**

In response to Appellant's argument that Muller '675 cannot be structurally modified by Emigh et al. '323, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

In this case, it is the teaching of providing an electromechanical actuator to a sheet gripper that provides the motivation to combine the references.

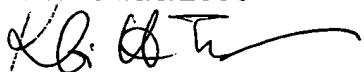
**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this Examiner's Answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

KHT 04/28/2006



Conferees:

Gene Crawford



Patrick Mackey